Attorney Docket No. P50464-1X1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
	)	
JACKSON et al.	)	
	)	
Serial No. 09/142,983	)	Group Art Unit: 1617
	)	
Filed: September 17, 1998	)	Examiner: T. Criares
	)	
For: PLA_2 Inhibitors for Angiogenesis	)	

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)(1)

Appellants submit this Reply Brief in response to the Examiner's Answer mailed October 1, 2002.

The Examiner summarily dismisses Appellants' Brief, urging that it "does not contain an argument upon which the examiner rejected claims 1-4, 7-9, and 13-17" and, consequently, contending that Appellants have acquiesced to the Examiner's rejection. Appellants did address the Examiner's rejection and most certainly did not acquiesce. Indeed, should the record reflect any acquiescence, it is on behalf of the Examiner who, in the Examiner's Reply, made no response to Appellants' arguments, except to urge acquiescence. Moreover, should there be any question regarding the cause for confusion regarding the rejection, there is no doubt that the prior Office

Action of January 18, 2001 (and the two pages of the Examiner's Grounds of Rejection (10) and Response to Argument (11)) commingled five distinct rejections:

1. Written description
2. Lack of antecedent basis
3. Indefiniteness
4. Non-statutory claims
5. Claims cannot encompass a limitation narrower than the specification

As to Appellants' "new matter" arguments, of course, the lack of support in the specification for an amendment can be cast in terms of new matter or lack of written description, as set forth in M.P.E.P. sections 2163.06, 606.03(O), and 608.04. And far from not responding to the outstanding rejections, Appellants addressed both new matter and lack of written description in the Appeal Brief. Taking them in reverse order, Appellant addressed the written description expressly at page 7, lines 3-21 of the Appeal Brief:

> Because the instant specification describes what an inhibitor of PLA_2 enzyme is, how to characterize the PLA_2 enzyme (as well as its being well known in the art), how to screen for them [page 14, line 36, and page 15 of the specification], Appellants contend that the specification does provide an adequate written description of what they are claiming.
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> * * *
>
> Appellants submit that one of skill in the art would readily understand what is meant by the date restriction in the pending claims. Whether the inventor or the public can define and list the entire set of compounds that are covered by the instant claims is not dispositive of whether the inventor had possession of the claimed invention at the time of filing.

Appellants continue this discussion on pages 8 and 9, line 19, and direct the attention of the Examiner to these passages rather than repeat them here. Thus, Appellants did fully address the rejection for lack of written description.

Similarly, the new matter aspect is addressed at page 5, line 8; page 6, lines 2-16, and elsewhere in the Appeal Brief.

In response to the notion that the claims are indefinite, Appellants again direct the attention of the Examiner to page 8, line 9 to page 9, line 19 of the Appeal Brief.

Appellants similarly refuted the notion that claims cannot encompass a limitation that is narrower than that which is disclosed in the specification, in the Appeal Brief at page 6, line 17 to page 17, line 16, but this bears emphasis here. Specifically, Appellants cited to *In re Johnson*, 191 U.S.P.Q. 187, 195-96 (C.C.P.A. 1977) and to *In re Wertheim*, 191 U.S.P.Q. 90, 97 (C.C.P.A. 1976) for support of the inclusion of the date provisos. Appellants did not cite the M.P.E.P. for this proposition, but the M.P.E.P. itself expressly relies upon *Johnson*, among other cases, for this proposition. Indeed, as set forth in M.P.E.P. § 2173.05(i), negative limitations are permitted where the "boundaries" of the patent protection sought is clear. There can be no question that the boundaries set forth by a date would be clear. Indeed, as set forth on page 9, lines 14-19, the phrases "known before" and "used before" have a statutory basis, and Examiners are long accustomed to searching for art that meets these criteria. Moreover, judges, lay juries, and patent practitioners are often asked to determine on what date certain knowledge became available to the public or when a particular use took place. Once this date is established, the only remaining question is whether the event took place before or after the date specified in the claims. There is nothing unclear or uncertain about the date provisos in these claims. Accordingly, Appellants have fully addressed this aspect of the Examiner's rejection.

Finally, the Examiner asserts for the first time that claims 13-17 "recite 'use of" compounds which render[s] the claims non-statutory under 35 U.S.C. 101." Appellants must confess to some confusion on this point. The language of Section 101 expressly permits patenting of "any new and useful **process,**" and the patents that the U.S. Patent and Trademark Office has issued for use of compositions are legion. Indeed, Appellants' prior brief recited such a claim at page 10. Accordingly, these claims should stand or fall with the composition claims, and Section 101 does not require the contrary.

As the foregoing demonstrates, Appellants did respond expressly to the Examiner's outstanding rejection. Having addressed and refuted the various bases of rejection, Appellants cannot have acquiesced in the Examiner's rejection. In the Examiner's Reply, the Examiner made no response to Appellants' arguments except to say that Appellants acquiesced to lack of support in the specification for the date proviso language. In addition, the Examiner indicated that the claims would be allowable if the proviso language were deleted. Accordingly, the record reflects that Examiner has acquiesced that the claims (absent the date proviso language) are patentable.

For the reasons set forth above, Appellants submit that the Examiner's basis for rejecting pending claims 1-4, 7-9, and 13-17 is improper and respectfully request that the Board reverse the Examiner.

Respectfully submitted,

GlaxoSmithKline

Dated: December 2, 2002

By: _____
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